

REMARKS

Claims 1, 8-10, 14-20, 25, 29, 31, 34, 41-43, 47-53, and 58 are pending in the instant application and are subject to restriction and/or election. Claim 34 has been amended to correct an obvious error. Support for the amendment can be found throughout the specification. No new matter has been added as a result of this amendment.

The Office Action requires restriction to one of the following inventions under 35 U.S.C. 121:

GROUP I, claims 1, 8-10, 14-20, 25, 29, and 31, drawn to a method for decreasing airway hyperresponsiveness or airway inflammation in an animal, comprising administering to said animal, an antisense compound 13 to 30 nucleobases in length, wherein the antisense compound is targeted to a nucleic acid molecule encoding a p38 α mitogen-activated protein kinase, classifiable in class 514, subclass 44; and

GROUP II, claims 34, 41-43, 47-53, and 58, drawn to an antisense compound 13 to 30 nucleobases in length targeted to a nucleic acid molecule encoding a p38 α mitogen-activated protein kinase, classifiable in class 536, subclass 24.5.

Applicant hereby elects Group II, with traverse, for continued examination.

Upon election of Group II, the Office Action requires election of one antisense compound as recited in claim 34: "That is, Applicants are required to elect one antisense compound targeted to either nucleotides 562 to 648 of SEQ ID NO:1; nucleotides 659 to 688 of SEQ ID NO:1; nucleotides 1194 to 1277 of SEQ ID NO:1; or nucleotides 3722 to 3747 of SEQ ID NO:127 from claim 34." Applicants hereby elect an antisense compound targeted to nucleotides 1194 to 1277 of SEQ ID NO. 1, with traverse.

Applicant respectfully traverses the requirement for restriction and submits that the requirement is improper.

Applicant asserts that the subject matter of the groups identified by the Examiner represent different embodiments of a single inventive concept, for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a single invention, which merit examination of all of these claims in a single application. More particularly, a single, searchable, unifying aspect links all of the pending claims. This single, searchable, unifying aspect comprises an antisense compound targeted to a nucleic acid molecule encoding a p38 α mitogen-activated protein kinase.

Furthermore, Applicant submits that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P.

states,

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803 (8th ed., Rev. No. 2, May 2004).

That is, even if the above-enumerated groups are drawn to patentably distinct inventions, the Examiner must still examine the entire application on the merits, because doing so will not result in a serious burden. This is especially true given the robust and extensive computerized search engines and databases at the Examiner's disposal.

Accordingly, it is respectfully requested that the restriction requirement be reconsidered.

Applicants further submit that the Patent Office has not shown a lack of unity of invention for the subject matter of the claims in question. A clear relationship is disclosed between the antisense compound and its administration in a method for decreasing airway hyperresponsiveness or airway inflammation. According to MPEP 808.01(a), "Where there is a relationship disclosed between species, such disclosed relation must be discussed" (by the Examiner) "and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction..." Applicants submit that reasons leading to the Examiner's conclusion that the disclosed relation does not prevent restriction have not been adequately advanced, and, as a result, the propriety of the restriction has not been established.

Accordingly, it is respectfully requested that the restriction requirement be withdrawn.

CONCLUSION

This constitutes a request for any needed extension of time and an authorization to charge all fees therefor to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to deposit account No. 19-5117.

Respectfully submitted,

/Marina Heusch/

Date: August 19, 2008

Marina I. Heusch
Patent Agent #47,647
Swanson & Bratschun, L.L.C.
8210 Southpark Terrace
Littleton, CO 80120
Telephone: (303) 268-0066
Facsimile: (303) 268-0065